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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/813,690      | 03/21/2001  | Tamim K. Mourad      | 1921-00101          | 3441             |

23505 7590 07/02/2003

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| EXAMINER |
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CHOP, ANDREA MARIE

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3677

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

OK

**Office Action Summary**Application No.  
**09/813,690**Applicant(s)  
**Mourad et al.**Examiner  
**Andrea Chop**Art Unit  
**3677**

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Notice of Art Unit Number Change***

1. Please note that the Art Unit number associated with this Application has changed to 3677.

### ***Priority***

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.

### ***Drawings***

3. It should be noted that the drawings have not yet been reviewed by a PTO draftsman. The drawings will be reviewed upon allowance of the application and Applicant will be apprised of their status accordingly.

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***Claim Rejections - 35 USC § 112***

4. Claims 6-9, 11 and 19-24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As concerns Claim 6, "said prices" is indefinite, since it is not clear which prices are being referred to. Also, the equation should be spelled out as to what is meant by the various characters, such as is done in Claim 3.

As concerns Claim 7, the abbreviation UPC should be spelled out for clarity of the claim language and to prevent ambiguity.

As concerns Claim 8, the abbreviation SKU should be spelled out for clarity of the claim language and to prevent ambiguity.

As concerns Claim 11, "the selected product" lacks antecedent basis.

As concerns Claim 19, "said customer" lacks antecedent basis.

As concerns Claim 23, "said customer" lacks antecedent basis.

As concerns Claim 24, "said customers" lacks antecedent basis.

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***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-26 show a series of steps which are grounded in the abstract idea of, for example, building a database and importing retail prices, and providing lists, etc. The broadly recited steps do not recite sufficient computer structure that are within "technological arts". Therefore, they do not satisfy the statutory requirements of 35 U.S.C. 101. See *In re Toma* 197 USPQ 852 (CCPA 1978).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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8. Claims 1, 2, 5, 7-9, 15-17 and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Dworkin US 4,992,940.

Dworkin teaches a database of products, a reference price (the average price) and retail price (the list price) (Fig. 6).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, 4, 6, 10-14 and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin US 4,992,940.

In regards to the specific type of reference price calculated and the nature of how such data is provided, it would have been an obvious matter of design choice to design the data as desired, since applicant has not disclosed that the particular design chosen is better than another design, and it appears that the invention would perform equally well with a different design, such as is shown in Dworkin. In regards to Claim 6, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to remove stale retailer prices since the examiner takes Official Notice that it is well known to update databases to remove stale data and

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the use of such a procedure would be within the level of ordinary skill in the art. In regards to Claim 10, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to include a way for the customer to directly access the retailer website to purchase the item, since the examiner takes Official Notice of the use of methods which link a customer to a retailer's website to purchase an item, and the use of such would be within the level of ordinary skill in the art. In regards to the specific type of reference price, it would have been an obvious matter of design choice to design the reference price data as desired, since applicant has not disclosed that this particular type of reference data is better than other types of reference data, and it appears that the invention would perform equally well with different types of reference data, such as that shown in Dworkin. In regards to allowing the customer to input target reference price differences, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to allow the customer to input price data and receive notification if such data is present, since the examiner takes Official Notice of the use of price data for seeking out specific products that are desired by a customer, and of notifying the customer when such data has fallen within the customer's specifications, and the use of such a process would be within the level of ordinary skill in the art; the use of notification by e-mail is well known in the art.

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***Patent Customers Advised to FAX Communications to the USPTO***

11. In view of delays in mail delivery in recent days, we at the USPTO would like to encourage you to communicate with the USPTO via facsimile. **Facsimile transmissions may be used for correspondence as set forth in 37 CFR 1.6 such as: amendments, petitions for extension of time, authorization to charge a deposit account, an IDS, terminal disclaimers, a notice of appeal, an appeal brief, CPAs under 37 CFR 1.53(d), and RCEs.**

PTO Form 2038 should be used when authorizing payment by credit card; this form is maintained separate from the file to ensure confidentiality.

The USPTO has recently installed server software that enables us to automatically receive facsimile transmissions and route them to the appropriate groups. No special equipment is needed by our customers to use this system other than a regular facsimile machine. Each Technology Center has its own facsimile numbers associated with our server for Official replies to non-final Office actions and for Official replies to final Office actions. In addition, each Technology Center has a Customer Service Center on our server system and can answer any general application status questions you might have, can provide Examiner information and answer paper queries.



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The following is a list of all Official Facsimile numbers for Technology Center 3600:

TC 3600:

Before Final 703-872-9326

After Final 703-872-9327

Customer Service 703-872-9325

By using the Official Before Final and After Final numbers, our server system will automatically generate a return receipt that will include the number of pages received as well as the date and time the facsimile was received. Additionally, the return receipt will include an image of the received cover page. Applicants are advised to use the certificate of facsimile transmission procedures when submitting a reply to a non-final or final Office action by facsimile (see 37 CFR 1.6 and 1.8). Applicants are also advised to retain the return receipt in the event that the Office has no record of the facsimile submission, whether the facsimile submission is a reply to an Office action (37 CFR 1.8(b)), or a continued prosecution application under 37 CFR 1.53(d) (37 CFR 1.6(f)).

**Note, however, the Office currently does not permit new application filings (other than a CPA under 37 CFR 1.53(d)), requests for reexamination, drawings, and certain correspondence set forth in 37 CFR 1.6(d) by facsimile.**

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*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

| reference       | why cited?   |
|-----------------|--|
| US 5,873,069    | description of general database for storing and reporting pricing information  |
| US 6,076,070    | discusses price comparison in which comparison is made between a price and a lower price, i.e., a reference price                |
| US 2001/0005833 | discusses price comparison between a desired price and a resale, i.e., a reference price   |
| US 2002/0016779 | discusses price comparison shopping in which customer specifies data, and the returned data includes retail and wholesale prices |

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea Chop whose telephone number is (703) 305-6358.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2168.

ANDREA CHOP  
PATENT EXAMINER  
Art Unit 3677

AMC  
June 26, 2003